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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,299

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Laurent Mainard

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EXAMINER

DENNISON, JERRY B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,299	Applicant(s) MAINARD, LAURENT	
	Examiner J Bret Dennison	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the amendment for Application Number 10/580,299 received on 5/4/2009.
2. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-14, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12-14 recite means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. For computer-implemented means-plus-function claim limitations that invoke 35 USC 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor, but must include the algorithm as well as the general purpose computer or microprocessor. Applicant's specification does not appear to disclose the appropriate algorithms for the corresponding structure for the limitations as claimed.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

3. Claim 18 recites, “wherein a single electronic messaging address is associated with said collaboration session”. However, this contradicts the limitations of the independent claim, which states that a plurality of messaging addresses are associated with the collaboration session manager. As such, claim 17 does not properly limit its

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independent claim and is therefore unclear as to the subject matter being sought for protection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 16 is rejected under 35 USC 101 since the claims are directed to non-statutory subject matter. Claim(s) 16 recites an information medium which appears to cover both transitory and non-transitory embodiments. While Applicant's Specification may or may not provide examples of a medium as claimed, such examples do not explicitly define the term. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a medium as claimed typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of the term, particularly when the specification is silent of an explicit definition. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a

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signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 6-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Qi et al. (US 2004/0215784).

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5. Regarding claims 1, 7, and 12-16, Qi disclosed a method of transferring at least one message for the establishment of a collaboration session (126) by a manager (125) of a collaboration session between a plurality of clients, characterized in that a messaging system (122) is associated with the collaboration session manager and in that the method comprises the steps of:

the reception (E500), by the messaging system associated with the collaboration session manager, of a message generated by a collaboration session client, the message comprising a plurality of addresses of clients of the collaboration session (Qi, [0023], Qi disclosed a user/client transmitting a request message that includes a list of invitees and their addresses),

the activation (E508) of a collaboration session by the collaboration session manager (Qi, [0025], Qi disclosed the starting of the collaboration session after receiving the request, by first setting up the participants),

the obtaining (E513) of an identifier for the collaboration session activated (Qi, [0026], [0030], Qi disclosed obtaining a collaboration session identification number or code),

the transfer (E515), for the establishment of the collaboration session, of at least one message intended for each collaboration session client address, the message comprising the identifier of the collaboration session activated (Qi, [0026], Qi disclosed the server inviting the invitees with a message including the session identification number).

and wherein a plurality of messaging addresses are associated with the messaging system associated with the collaboration session manager, and a type collaboration session corresponds to each messaging address (Qi, [0023], [0029], Qi disclosed a bunch of messaging addresses associated with the messaging system, i.e. the client addresses that are part of the sessions being held, and since the sessions are being held, each one clearly has a type, and therefore the messaging addresses correspond to a type of collaboration system).

Claim 7 includes a method with limitations that are substantially similar to claim 1. Claims 12 and 13 include a device with limitations that are substantially similar to claim 1. Claim 14 includes a system with limitations that are substantially similar to claim 1. Claims 15 and 16 include a computer program with limitations that are substantially similar to claim 1. Qi disclosed a method, device, system, and program performing these limitations (Qi, [0007]-[0012], [0021]). As such, claims 7 and 12-16 are rejected under the same rationale.

6. Regarding claim 2, Qi disclosed the limitations as described in claim 1, characterized in that the message generated by the client of the collaboration session is an electronic message comprising the messaging address of the client who generated the message and the messaging address of the plurality of clients of the collaboration session (Qi, [0023]).

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7. Regarding claim 3, Qi disclosed the limitations as described in claim 2, characterized in that temporal information is associated with the electronic message (Qi, [0026]).

8. Regarding claim 4, Qi disclosed the limitations as described in claim 2, characterized in that other messaging addresses are included in the electronic message and the method also comprises a step of determining, amongst the messaging addresses included in the electronic message, messaging addresses of the clients of the collaboration session (Qi, [0023]).

9. Regarding claim 6, Qi disclosed the limitations as described in claim 5, including wherein accreditations are allocated to the clients of the collaboration session and the message transferred to each client of the collaboration session comprises the allocated accreditation (Qi, [0026] and [0030]).

10. Regarding claim 8, Qi disclosed the limitations as described in claim 7, characterized in that the message generated by the messaging system associated with a collaboration session manager is an electronic message and in that temporal information is associated with the electronic message (Qi, [0023], [0026]).

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11. Regarding claim 9, Qi disclosed the limitations as described in claim 8, characterized in that, prior to the establishment of the session (i.e. the first user to start the collaboration session), the method also comprises the steps of:

displaying the identifier of the collaboration session (Qi, [0030], invitees are provided with the identifier, and also must provide the identifier which clearly would utilize displaying the identifier),

detecting a command made by the client for establishing the collaboration session ([0030], First user's request to would establish the session).

12. Regarding claim 10, Qi disclosed the limitations as described in claim 9, characterized in that, prior to the step of establishing a collaboration session, the method comprises a step of activating collaboration software associated with the client (Qi, [0020], a client establishing a session clearly requires the client to use collaboration software).

13. Regarding claim 11, Qi disclosed the limitations as described in claim 10, characterized in that the method also comprises the step of generating, by means of the messaging system associated with the client of collaboration session, a message intended for the messaging system associated with the collaboration session manager, the message comprising the messaging address of the client of the collaboration session (Qi, [0023], [0026], [0028]).

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14. Regarding claim 17, Qi disclosed the limitations as described in claim 1 including wherein said type of said collaboration session is associated to a specific messaging address (Qi, [0023]).

15. Regarding claim 18 Qi disclosed the limitations as described in claim 1 including wherein a single electronic messaging address is associated with said collaboration session manager (Qi, [0023]). and wherein said type of said collaboration session is specified in a body of said message, by means of a predetermined keyword (Qi, [0026]).

Response to Arguments

Applicant's arguments with respect to the rejections under 35 USC 102 under the Qi reference have been considered but are not persuasive.

Applicant's argues "Qi et al. does not suggest that the 'request' which is transmitted to the CSM can be of various types, each type corresponding to a specific address associated with the plurality of addresses of the messaging system" (Response, 9).

In response to applicant's argument that the references fail to show these features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). The claim merely recites "wherein a plurality of messaging addresses are associated with the messaging system associated with the collaboration session manager, and a type collaboration session corresponds to each

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messaging address". This limitation has nothing to do with a request. The limitation merely recites that addresses that are associated with the session manager corresponds to a type of collaboration session. Qi clearly disclosed addresses associated with the system (such as the client addresses) and that they are clearly a part of a collaboration session, and therefore they are associated with a collaboration session type.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures

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may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/J Bret Dennison/

Primary Examiner, Art Unit 2443